

REMARKS

The present amendment is responsive to the Official Action mailed on April 10, 2009. A petition for a two-month extension of the term for response to said Official Action, to and including September 10, 2009, is transmitted herewith.

Claims 24, 25, and 47-62 are pending, claim 24 having been withdrawn from consideration subsequent to an earlier restriction requirement. Claim 25 has been amended, claims 47-62 have been added, and claims 26-46 have been canceled by the present response. No new matter is presented by these amendments.

In view of the above amendments and within remarks, reconsideration of the Examiner's rejections is respectfully requested.

I. ELECTION/RESTRICTIONS

Applicants hereby affirm the provisional election made on April 2, 2009 to prosecute the invention of Group II, claims 25 and 44-46.

II. CLAIM REJECTIONS - 35 U.S.C. § 112

In the Official Action, the Examiner rejected claims 44-46 under 35 U.S.C. § 112, second paragraph, as being indefinite. Claims 44-46 have been canceled herein. Accordingly, the rejection of those claims should be withdrawn.

III. CLAIM REJECTIONS - 35 U.S.C. § 102

In the Official Action, the Examiner rejected claims 25, 45, and 46 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,030,705 to Buoniconti et al. ("Buoniconti").

Currently amended independent claim 25 provides "[a] method of converting a surface top into a promotional medium in a commercial eating and/or drinking establishment in which the

surface top is used by customers." The method includes providing a surface top covering which is readily removable and replaceable "after a specified length of time" (e.g., whenever the organization paying for the promotional medium wishes to change the content of the medium, which could be, for example, after a few days, or a week, or a month). The invention, therefore, "allow[s] complete removal of the surface top covering." In this regard, a "semi-permanent adhesive layer" (emphasis added) is provided to affix the surface top covering to the surface top.

Buoniconiti teaches a thermoplastic resin film 14 and a process of applying the film to a counter 10 to form a "durable work surface." (See *Buoniconiti* col.1 l.40.) By the process, "a scratched or worn countertop may be rehabilitated with minimal effort and skills by covering the worn surface with [the thermoplastic resin film 14]." (*Buoniconiti* col.1 ll.27-30.) The film 14 may be clear and the back surface 16 may include printing, such as decorative graphics or advertising. The film 14 is adhered to the counter 10 by a pressure-sensitive adhesive 15, which is noted as being "aggressive and sticks quickly." (*Id.* col.2 ll.36-37.) The adhesive is "strong enough to resist peel-up, unless deliberate, strong force is used." (*Id.* col.3 ll.24-25.) Due to the aggressive and sticky nature of the adhesive, "[i]f replacement is needed, adhesive that remains on the high-pressure laminate surface after the film is peeled away can be removed using a wood chisel." (*Id.* col.3 ll.25-28.) Thus, the aggressive pressure sensitive adhesive is, in effect, a permanent adhesive.

Thus, *Buoniconiti* provides a countertop which is intended to be permanent (although replaceable). *Buoniconiti* teaches that the benefit of his invention is that, in high-abuse areas, where countertops may need to be replaced frequently, his countertop is easier (i.e., less time consuming and messy) to

install. (See *id.* col.3 11.8-18.) Thus, replacement of the existing permanent countertop is determined only when the existing permanent countertop is worn and scratched.

In contrast to the permanent, replaceable countertop taught in *Buoniconti*, Applicants' invention recited in currently amended claim 25 provides a temporary surface top covering, which converts the surface top "into a promotional medium" and which is readily removable and replaceable, by virtue of the "semi-permanent adhesive," "after a specified length of time" (e.g., whenever the organization paying for the promotional medium wishes to change the content of the medium). There is no teaching or suggestion in *Buoniconti* to affix the countertop with "semi-permanent adhesive" and to remove the countertop "after a specified length of time." Indeed, as discussed above, the "aggressive" adhesive taught by *Buoniconti*, which requires a wood chisel to remove, is not "semi-permanent," as recited in claim 25. Additionally, *Buoniconti* teaches replacing the countertop only "if replacement is needed" (emphasis added) and after the countertop is worn from "high-abuse," not "after a specified length of time."

Thus, *Buoniconti* does not teach or suggest all of the features of independent claim 25, and it is respectfully requested that the rejection of that claim as anticipated by *Buoniconti* be withdrawn.

Furthermore, the problem overcome by *Buoniconti* (i.e., the permanent replacement of a worn and scratched countertop in a high-abuse area) is totally unrelated to Applicants' invention (i.e., providing a readily replaceable surface top covering to convert a surface top into a promotional medium in a commercial eating and/or drinking establishment). Therefore, one of ordinary skill in the art would not have looked to *Buoniconti* for a solution to the problem, and thus claim 25 would not have been obvious in view of *Buoniconti*.

IV. CLAIM REJECTIONS - 35 U.S.C. § 103

In the Official Action, the Examiner rejected claim 44 under 35 U.S.C. § 103(a) as being obvious over *Buoniconiti* in view of JP 2003-154795 to Kato et al. ("*Kato*").

Claim 44 has been canceled herein. However, it is noted that new dependent claim 61 contains some similar features to those included in claim 44. *Kato* has not been relied on as remedying any of the deficiencies of *Buoniconiti* identified above. Therefore, at least due to the dependency of claim 61 from independent claim 25, claim 61 is asserted to be allowable over the prior art of record.

V. DEPENDENT CLAIMS

Applicants designate dependent claims 47-62 as being allowable at least due to their ultimate dependency from independent claim 25, which was argued above to be allowable. Although Applicants have not separately argued the patentability of each of the dependent claims, Applicants' failure to do so is not to be taken as an admission that the features of the dependent claims are not themselves separately patentable over the prior art cited by the Examiner.

VI. CONCLUSION

As it is believed that all of the rejections set forth in the Official Action have been fully met, favorable reconsideration and allowance are earnestly solicited.

If, however, for any reason the Examiner does not believe that such action can be taken at this time, it is respectfully requested that the Examiner telephone Applicants' attorney at (908) 654-5000 in order to overcome any additional objections which he might have.

Application No.: 10/590,806

Docket No.: DAVIDK 3.3-017

If there are any additional charges in connection with this requested amendment, the Examiner is authorized to charge Deposit Account No. 12-1095 therefor.

Dated: September 9, 2009

Respectfully submitted,

By 

Gregory M. Reilly

Registration No.: 64,006

LERNER, DAVID, LITTENBERG,

KRUMHOLZ & MENTLIK, LLP

600 South Avenue West

Westfield, New Jersey 07090

(908) 654-5000

Attorney for Applicants

1039915_1.DOC